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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,319	02/27/2004	Frank Y. Xu	P121/MII-93-68-03	9202

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EXAMINER

ZIMMER, MARC S

ART UNIT PAPER NUMBER

1712

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/789,319

Applicant(s)

XU ET AL.

Examiner

Marc S. Zimmer

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 15-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 15-19 is/are allowed.
- 6) ☒ Claim(s) 1-12 and 20-31 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09/26/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Information Disclosure Statement***

In response to Applicant's remarks concerning the enormous size of their Information Disclosure Statement, the Examiner would first like to say that it is appreciated that Applicant takes their responsibilities related to full disclosure seriously. It is also acknowledged that it is not always possible to ascertain what might, and might not, be deemed relevant by the Examiner and, therefore, it is sometimes better to err on the side of caution. That being said, ALL of the claims of the present disclosure are directed to chemical compositions that, at a minimum, contain a silicone resin and a crosslinking agent. The vast majority of references cited by Applicant, which number in the high hundreds, do not even make cursory mention of a silicone resin so it is doubtful that Applicant could have mistakenly believed that these documents were somehow useful to the Examiner's pursuit of becoming familiar with the most germane prior art. In fact, Applicant's actions are contrary to that goal because the Examiner had to spend an inordinately long period of time just entering the references into the available electronic databases and then make at least a quick determination of the merits of each document. This time would have been better spent doing a more comprehensive, and targeted, search for chemical compositions that resemble those contemplated by Applicant's claims.

Applicant is advised that the Examiner has reviewed the electronic images of the sheets citing the references emphasized by Applicant and made the determination that these references have been considered. As on the other pages of Applicant's

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Disclosure statement, the Examiner has initialed the first and last references cited and drawn a line between initialed boxes to reflect that they too were considered.

### ***Claim Objections***

Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1 now requires an aminoplast crosslinker so the subject matter of claim 7 is no longer further limiting of the invention recited in claim 1.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 and 20-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. At issue is Applicant's assertion that the amendments to claims 1 and 20 are properly supported by the original disclosure. While the Examiner agrees that the skilled artisan would appreciate that silsesquioxane polymers adhere to the formula currently mentioned in claims 1 and 20, it is the Examiner's position that the broad class of organo-substituted silsesquioxanes is not

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properly supported. The only paragraph that is directed to any discussion of the suitable silicon-based polymers is paragraph 34. In original paragraph 34, there is a suggestion that polysiloxanes having any structural attributes whatsoever may be employed in the practice of their invention. Hydrogen silsesquioxane is mentioned but organo-functional silsesquioxanes are not given even cursory mention anywhere in the original Specification. In fact, the ONLY support that Applicant might have for this class of polymers is in their mention of Z-6018, which the Examiner hasn't even been able to confirm IS a silsesquioxane. (It is appreciated that Applicant has referred to this product as "T-resin" intermediate but the MSDS associated with this material says only that it is a resin without further expounding on its structure. The Examiner was unable to retrieve from the Dow Corning Web site any additional information confirming that, in fact, Z-6018 is a silsesquioxane.)

Assuming that Z-6018 is, in fact, a silsesquioxane polymer, which Applicant has yet to illustrate, and, hence, adheres to the structural description now recited in claim 1, the mere fact that this single product is mentioned does not lend support to an entire category of polymer materials.

Further, concerning claim 20 and the claims dependent therefrom, just as the mention of Z-6018 does not properly support Applicant's claims to the whole genus of organosilsesquioxanes, it, likewise, does not lend proper support to Applicant's present requirement that the resin be a solid material. Indeed, there appears to be no indication in the original disclosure that solid silicone resins are even favored, let alone mandated.

*Any attempt to remedy these issues in the claims should be replicated in the Specification.*

Claims 1-12 and 20-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The formula that Applicant has added to clarify the structure of the silsesquioxane includes a variable "R" where said variable is not defined anywhere in the original disclosure.

Applicant is advised that, should the claims be amended to once again have the same scope as the original claims, they will, of course, be subject to rejection over the prior art of record.

***Allowable Subject Matter***

Claims 15-19 remain allowable for the reasons made of record previously.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 15, 2005

*Marc Zimmer*  
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